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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,584	02/15/2005	Shigeki Matsunaga	2005_0194A	6555

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WASHINGTON, DC 20006-1021

EXAMINER
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CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/524,584

Applicant(s)

MATSUNAGA ET AL.

Examiner

Minh H. Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 11-48 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :02/15/2005; 05/12/2005; 06/14/2006 & 09/26/2006.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The claimed invention in **claim 48** is directed to non-statutory subject matter.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process. The Applicant should revise the claim language to include the recitation such as -- *A computer readable storing medium which stores a program* --.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-4, 6-9, 11-27, 30-46, 47 and 48** are rejected under 35 U.S.C. 102(b) as being anticipated by ***Hisamoto*** (JP 2002-259108A).

With respect to **claims 1, 30, 42, 47, and 48**, ***Hisamoto*** teaches a print system (Fig. 8) for printing print data provided from a server or a print data supply device (316) to a registered user or device (318) that is authorized to access print data, the system comprising a client device or a print instruction device (318) and a print device (317),

wherein the print instruction device (318) includes a print instruction unit (305) operable to transmit, to the print device (317) a print instruction to print the print data in the print data supply device (316), with authentication information given only to the user or the device, and the print device (317) comprise a print control unit (302) includes a data requesting unit operable to transmit the authentication information with the print instruction to the print data supply device (316) and request the print data supply device to transmit the print data and a print control unit (302) includes a data receiving unit operable to receive the print data from the print data supply device (see Figs. 8-9 and paragraphs [0071-0091]).

With respect to **claims 2 and 43**, see Fig. 8 and paragraphs [0078-0088] of *Hisamoto* that teaches the print instruction device (318), the print instruction unit (305) includes a print instruction transmitting unit operable to transmit, to the print device (317), a print instruction to print the print data, and the print instruction transmitting unit transmits, to the print device, the authentication information and the print instruction that are in one to one correspondence; and in the print device (317), the data requesting unit (301) transmits the authentication information corresponding to the print instruction to the data supply device (316) and requests the print data.

With respect to **claims 3 and 44**, see Fig. 8 and paragraphs [0078-0088] of *Hisamoto* that teaches the print instruction unit (318) comprises print demand/request unit or a print instruction information generating unit (305) operable to generate print instruction information that is obtained by integrating print data position information indicating a storage location of the print data with the authentication information (304);

and a print instruction information transmitting unit operable to transmit the print instruction information to the print device (317); and in the print device (317), the data requesting unit: first, extracts the print data position information and the authentication information from the print instruction information and second, requests a transmission of the print data indicated in the print data position information (print data information such as print data position, print data font, print data density, etc. are included in the print data information and the print instruction)

With respect to **claims 4 and 45**, see Fig. 8 and paragraphs [0078-0079] of *Hisamoto* that teaches in the print instruction device (318), the print instruction unit (305) transmits the print instruction information to the print device through a secure communication path established between the print instruction device (318) and the print device (317).

With respect to **claims 6, 32 and 33**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches in the print instruction device (318), the print instruction unit includes (305) a print instruction information generating unit operable to generate print instruction information that is obtained by integrating print data position information indicating a storage location of the print data with the authentication information; a client device including (318) a print instruction information transmission notifying unit (communicating) operable to notify (transmitting operation) the print device (317) of a transmission of the print instruction information; and a print instruction information transmitting unit operable to transmit the print instruction information to the print device after the notification; and in the print device (317), the data requesting unit (302),

according to the notification, i) receives the print instruction information, ii) extracts the print data position information and the authentication information from the print instruction information, and iii) requests a transmission of the print data indicated in the print data position information.

With respect to **claim 7**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches a communication path between the print instruction device (318) and the print device (317) is a communication path composed of a command communication path for transmitting and receiving a command and a data communication path for securely transmitting and receiving data the print instruction information transmission notifying unit notifies the print instruction information transmitting unit, through the command communication path, to transmit the print instruction information and the print instruction information transmitting unit transmits, after receiving the notification, the print instruction information through the data communication path.

With respect to **claims 8 and 46**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches in the print instruction device, the print instruction unit (318) includes a print instruction information generating unit (302) operable to generate print instruction information obtained by integrating print data position information indicating a storage location (includes in the print data information) of the print data with the authentication information (304); and a position information notifying unit (communicating) operable to notify the print device of position information indicating the storage location of the generated print instruction information, and in the print device, the data requesting unit i) understands the notification (transmitting of information) of

the position information as a print instruction, ii ) receives, based on the notified position information, the print instruction information from the print instruction device, iii) extracts the print data position information and the authentication information from the print instruction information, and iv) requests a transmission of the print data indicated in the print data position information.

With respect to **claim 9**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches a communication path between the print instruction device and the print device is a command communication path for transmitting and receiving a command and a data communication path for securely transmitting and receiving data, in the print instruction device, the position information notifying unit notifies the print device (317) of position information of the print instruction information through the command communication path, and in the print device, the data requesting unit receives, based on the notified position information, the print instruction information through the data communication path.

With respect to **claim 11**, see Fig. 8 and paragraphs [0080-0088] of *Hisamoto*

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that teaches in the print device (317), the print control unit (302) include the data receiving unit establishes an encrypted communication path between the print device (371) and the print data supply device (316) using the authentication information and receives the print data through the encrypted communication path.

With respect to **claims 12 and 37**, see paragraphs [0084-0085] of *Hisamoto* that teaches the authentication information includes a decryption key which is data for decrypting the encrypted print data.



With respect to **claim 13**, see Fig. 8 and paragraphs [0076-0085] of *Hisamoto* that teaches in the print device (317), the data receiving unit includes an encrypted data receiving unit (303) operable to receive the encrypted print data and a print data decrypting unit operable to decrypt the received print data using the authentication information.

With respect to **claims 14 and 38**, see Fig. 8 and paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information includes information for identifying the print instruction device or information for identifying the user of the print system.

With respect to **claim 15**, see Fig. 8 and paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information is a pair of an identification (ID) of the print instruction device or an ID of the user of the print system, with a password.

With respect to **claim 16**, see Fig. 8 and paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information is described in the print data position information.

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With respect to **claims 17, 26 and 41**, see Fig. 8 and paragraphs [0086] of *Hisamoto* that teaches in the print device, the data requesting unit terminates or discards the authentication information after the data receiving unit has received the print data or after the completion of the printing process.

With respect to **claim 18**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the print data supply device comprises a request receiving unit operable to receive a transmission of print data corresponding to the print data, a user identifying

unit operable to identify the print instruction device or the user using the received authentication information, an authenticating unit operable to authenticate whether or not the identified print instruction device or the user is authorized to access the requested print data; and a data transmitting unit operable to transmit the requested print data to the print device if the access is permitted as the result of the authentication.

With respect to **claim 19**, see Fig. 5 and paragraphs [0061-0070] of *Hisamoto* that teaches the print instruction device (218) has a communication session with the print data supply device (216) and obtains an authentication from the authenticating unit before instructing the printing, the authentication information is communication session information issued to the print instruction device from the print data supply device in the communication session, and the communication session information includes information indicating that the print instruction device or the user has been authorized to access the print data.

With respect to **claim 20**, see Fig. 5 and paragraphs [0061-0070] of *Hisamoto* that teaches in the print instruction device (218), the print instruction unit includes a communication session information storing unit operable to store the communication session information issued from the print data supply device (216) through a communication path established in advance between the print data supply device and the print instruction device, and the print instruction device transmits the print instruction by attaching the communication session information as the authentication information, and in the print device, the data requesting unit transmits the authentication information to the print data supply device and requests a transmission of the print data, and the

print data supply device receives the authentication information that is the communication session information, skips processes in the user identifying unit and the authenticating unit and transmits the requested print data to the print device.

With respect to **claim 21**, see paragraphs [0061-0070] of *Hisamoto* that teaches the communication session information is a Cookie (inherent feature when devices are communicating) issued to the print instruction device by the print data supply device.

With respect to **claim 22**, see paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information includes a public key of a certificate authority for verifying a public key certificate of the print data supply device, in the print device, the encrypted communication path establishing unit, while verifying that the print data supply device is an authorized access destination using the public key of the certificate authority, establishes a Secure Socket Layer (SSL) or a Transport Layer Security (TLS) between the print data supply device and the print device, and in the print data supply device, the data transmitting unit transmits the requested print data to the print device through the SSL or the TLS.

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With respect to **claim 23**, see paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information further includes a public key of a certificate authority for verifying a public key certificate of the print data supply device.

With respect to **claim 24**, see paragraphs [0076-0086] of *Hisamoto* that teaches in the print device (217), the data requesting unit terminates or discards the authentication information after transmitting the authentication information to the print data supply device (after completion or the printing process), the print data supply

device includes (216) a user identifying unit (103) operable to identify the print instruction device or the user using the received authentication information; an authenticating unit (104) operable to verify whether or not the identified print instruction device or the identified user has been authorized to access the requested print data; and a data transmitting unit operable to, when the access is permitted as the result of the authentication, newly print request operation which include newly issue authentication information that can be used continuously by the print device and transmit the requested print data to the print device.

With respect to **claim 25**, see paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information to be newly issued is a pair of an identification (ID) of the print data supply device (216) with a password, or communication session information between the print data supply device (216) and the print device (217).

With respect to **claim 27**, see Fig. 8 and paragraphs [0076-0079] of *Hisamoto* that teaches in the print instruction device (218), the print instruction unit (302) transmits the authentication information to the print device (217) through a secure communication path established between the print device and the print instruction device.

With respect to **claim 31**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the data requesting unit (302) i) receives, from the print instruction device (218), a print instruction to print the print data and the authentication (304) information in one to one correspondence, ii) transmits the authentication information corresponding to the print instruction to the print data supply device (216), and iii) requests the print data.

With respect to **claim 34**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the data requesting unit (302), i) receives, from the print instruction device (218), a notification (communication) of position information indicating a storage location of print instruction information that is obtained by integrating print data position information (include in the transmitting print data) indicating a storage location of the print data with the authentication information, ii) recognizes the notification of the position information as a print instruction, iii) receives the print instruction information from the print instruction device based on the notified position information, iv) extracts the print data position information and the authentication information from the print instruction information, and v) requests a transmission of print data indicated in the print data position information.

With respect to **claim 35**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the authentication information includes identification information for identifying the authentication information, the print device (217) further includes an authentication information storing unit (111) operable to keep storing the received authentication information even after the print data has been printed, and the data requesting unit (302), i) receives, from the instruction device (218), the print information with the identification information, ii) reads out the authentication information specified by the received identification from the authentication information storing unit, and iii) transmits the authentication information to the print data supply device (216).

With respect to **claim 36**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the data receiving unit (302), i) establishes an encrypted communication

path between the print data supply device (216) and the print device (217) using the authentication information, and ii) receives the print data through the encrypted communication path.

With respect to **claim 39**, see Fig. 8 and paragraphs [0078-0091] of *Hisamoto* that teaches the data requesting unit newly receives, from the print data supply device, authentication information that can be used in continuation, after transmitting the authentication information to the print data supply device and after discarding the authentication information, and the data receiving unit receives the requested print data from the print data supply device.

With respect to **claim 40**, see Fig. 8 and paragraphs [0076-0085] of *Hisamoto* that teaches the authentication information is a pair of an identification (ID) of the print instruction device or an ID of the user of the print system, with a password.

### ***Claim Rejections - 35 USC § 103***

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**5.** ~~The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:~~

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 28 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hisamoto* as applied to claims 1-4, 6-9, 11-27, 30-46, 47 and 48 above.

With respect to **claim 28**, **Hisamoto** teaches all the limitation as explained in the rejection above, except for the recitation of *"the print instruction device and the print data supply device are included in a same device."*

**Hisamoto** teaches the print instruction device (218) and the print data supply device (217). It would have been obvious to one of skill in the art at the time of invention was made to modify the print instruction device and the print data supply device in a same device for the advantage of reduce the complicate connection between devices and space saving. Also, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine sill in the art Howard v. Detroit Stove Works, 150 US 164 (1893).

With respect to **claim 29**, **Hisamoto** teaches all the limitation as explained in the rejection above, except for the recitation of *"the print instruction device and the print device are connected to each other by a Bluetooth (TM)."*

While **Hisamoto** does not teaches the print instruction device (218) and the print device (217) are connected to each other by *Bluetooth*; the technology of using wire less or *Bluetooth* communication between devices has been known in the computer and printing technology. It would have been obvious to one of skill in the art at the time of invention was made to modify the printing system of **Hisamoto** to include the wire less or Bluetooth connection between the print instruction device and the print device for the advantage of allow devices can by set at a remote design location without complicate connection by wire.

***Allowable Subject Matter***

7. **Claims 5 and 10** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

**Claim 5** has been indicated for containing allowable subject matter because the prior art fail to teach the combination of a print system for printing data from a print data supply device or a registered user or device that is authorized to access print data including in the print instruction device, the print instruction unit further includes a print instruction information storing unit operable to store the generated print instruction information into a memory card medium inserted to the print instruction device, and in the print device, the data requesting unit includes a print instruction information reading unit operable to read the print instruction information from the memory card medium inserted to the print device, and the data requesting unit extracts the print data position information and the authentication information from the read print instruction information.

**Claim 10** has been indicated for containing allowable subject matter because the prior art fail to teach the combination of a print system for printing data from a print data supply device or a registered user or device that is authorized to access print data comprising the print instruction unit include an authentication information transmission history storing unit operable to store a history of authentication information transmitted



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to the print device, a transmission history judging unit operable to judge whether or not authentication information to be transmitted to the print device has been transmitted to the print device, when the transmission history judging unit judges that the authentication information has been transmitted to the print device, the print instruction device transmits the print instruction with the identification information instead of the authentication information and the print device further includes an authentication information storing unit operable to keep storing the received authentication information even after the print data has been printed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant's attention is invited to the patents to **Kanematu** (US Pat. # 7,130,066) and **Kou et al.** (Pub. No. US 2002/0099936A1).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H. Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHC  
March 05, 2007

  
**MINH CHAU**  
**PRIMARY EXAMINER**